

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Josef Laumen et al.
Serial No.:	10/516,776
Date Filed:	December 3, 2004
Group Art Unit:	2611
Confirmation No.:	5309
Examiner:	Fotakis, Aristocratis
Title:	TRANSMISSION OF MMS MESSAGES WITH THE CONVERSION OF DATA TYPES AND/OR DATA FORMATS

MAIL STOP – AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This Application has been carefully reviewed in light of the Final Office Action mailed November 25, 2009 (“Final Office Action”). At the time of the Final Office Action, Claims 12-24 were pending in this Application. Claims 12-24 were rejected. Claims 1-11 were previously cancelled without prejudice or disclaimer. No claim amendments are hereby requested. This Request is being filed concurrently with a Notice of Appeal.

ARGUMENTS

Rejections under 35 U.S.C. § 103

Claims 12-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over International Patent Publication No. WO 02/43414 by Miraj Mostafa (“*Mostafa*”) in view of U.S. Patent No. 6,061,696 issued to Richard Daniel Lee et al. (“*Lee*”). Applicants respectfully traverse as the cited art combination, even if proper, which Applicants do not concede, does not render the claims obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on *ex post* reasoning. *KSR*, 127 S. Ct. at 1742.

The proposed *Mostafa-Lee* combination fails to teach each and every element of Applicants’ claims. For example, the proposed *Mostafa-Lee* combination fails to teach at least the following features of independent Claim 12:

after the conversion, automatically updating a preexisting link either in the data or between different data elements maintain a validity of the preexisting link.

Specifically, the proposed *Mostafa-Lee* combination fails to teach *automatically updating a preexisting link either in the data or between different data elements maintain a validity of the preexisting link*.

The Examiner agrees with Applications that *Mostafa* does not disclose this feature. Office Action at 3–4. However, the Examiner argues that *Lee* provides an applicable teaching: “Lee teaches of updating a link, after format conversion to maintain a validity of the

link in the data between different data elements (Col 2, Lines 45 – 67 to Col 3, Lines 1 – 20 and Figs. 8 and 12).” Office Action at 4. However, the cited portion of *Lee* does not teach or suggest *automatically updating a preexisting link either in the data or between different data elements maintain a validity of the preexisting link*.

Lee describes a website editing application that allows a user to edit a data file, e.g., a native image file such as RGB, in one format and automatically propagate any changes into a web compatible format, e.g., JPG, for immediate viewing within a web page editor or browser. *Lee*, col. 3, ll.7–15. *Lee* provides a user with an interface wherein a user can manually select an original file that will be automatically converted to a local file every time the user modifies the original file. Thus, *Lee* is not at all analogous to or even relevant to the problem addressed by the present invention, which addresses automatic conversion of data contained in MMS messages while in transit from a sender to a recipient. The Examiner appears to be analogizing a media file, as discussed in *Lee*, with a “data element” recited in Applicants’ claims. However, Claim 12 recites updating a “a preexisting link either in the data or between different data elements.” Thus, the Examiner’s analogy fails because *Lee* does not teach anything similar to a *link*—either in or between the media files—that is automatically updated.

Lee does not disclose automatically updating a preexisting link after a media file conversion. The application disclosed in *Lee* allows the user to specify the original media file name 86, local media file name 87 and published URL referencing the local media file 87 (*Lee*, fig. 8 and col. 8, ll.16–19). *Lee* simply converts the contents of the original file and saves the converted contents to the local file every time the original file is modified by the user (*Lee*, col. 6, ll.47–59). Therefore, the application disclosed in *Lee* does not automatically update a preexisting *link* to data, but only updates the contents of the local *file*, preexisting or otherwise. *Lee*, col. 6, l.66–col. 7, l.2. *Lee* explains: “After Cosmo™ Create has converted (if necessary) and saved a local copy of the object file, the Cosmo™ Create window is refreshed to display the page with the altered object (step 374).” *Id.* After the file conversion, the viewing window is merely refreshed with an updated copy of the converted image. *Lee* does not teach automatically updating a preexisting link within the displayed web page after the file conversion to maintain the validity of that preexisting link. The Published URL of *Lee* cannot not satisfy the missing claim feature because the URL is a static element

that is never automatically updated. Thus, *Lee* does not teach or suggest *automatically updating a preexisting link either in the data or between different data elements maintain a validity of the preexisting link*.

Even if a person of ordinary skill in the art would consider the teachings of *Lee* in view of *Mostafa*—a proposition Applicants dispute—that person would not know to automatically update a preexisting link to maintain its validity. The proposed *Mostafa-Lee* combination might be able to convert the data of an MMS packet, but would rely on the user to manually link that newly converted data, in advance of the conversion, so that it could be viewed after conversion.

For at least these reasons, amended independent Claim 12 is allowable over the proposed *Mostafa-Lee* combination. Therefore Applicants respectfully request reconsideration and allowance of Claim 12 and Claims 13–17 that depend from Claim 12.

In another example, the proposed *Mostafa-Lee* combination fails to teach at least the following features of independent Claim 18:

an apparatus for receiving the data from the first subscriber terminal wherein the apparatus performs at least one of a data type and a data format conversion on at least one of the data elements in accordance with a profile of a second subscriber terminal which is to receive the data, and automatically updates a preexisting link in the MMS data linking the different data elements, including the at least one converted data element within the MMS data, after the conversion, to maintain a validity of the preexisting link in the data between the different data elements.

For at least the same reasons discussed above with respect to independent Claim 12, the proposed *Mostafa-Lee* combination fails to teach an apparatus that *automatically updates a preexisting link in the MMS data linking the different data elements to maintain a validity of the preexisting link*. Therefore, Applicants respectfully request reconsideration and allowance of Claim 18 and Claims 19–23 that depend from Claim 18.

In another example, the proposed *Mostafa-Lee* combination fails to teach at least the following features of independent Claim 24:

to automatically update a preexisting link in the MMS data linking the different data elements, including the at least one converted data element within the MMS data, after the conversion, to maintain a validity of the preexisting link in the data between different data elements prior to the data being sent to the further subscriber.

For at least the same reasons discussed above with respect to independent Claim 12, the proposed *Mostafa-Lee* combination fails to teach a computer program enabled to *automatically update a preexisting link in the MMS data linking the different data elements to maintain a validity of the preexisting link*. Therefore, Applicants respectfully request reconsideration and allowance of Claim 24.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is authorized to charge the fee of \$540.00 required to Deposit Account 50-4871 in order to effectuate this filing. Applicants believe there are no other fees due at this time. However, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-4871.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457.2031.

Respectfully submitted,
KING & SPALDING LLP
Attorneys for Applicants



Truman H. Fenton
Registration No. 64,766

Date: 2/15/10

SEND CORRESPONDENCE TO:
KING & SPALDING LLP
CUSTOMER ACCOUNT NO. **86528**
512.457.2031
512.457.2100 (fax)